



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,967	02/27/2004	Joseph Anthony Gatto	8725R2R	9429
27752 7590 10/14/2009 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
EXAMINER				
PAGONAKIS, ANNA				
ART UNIT		PAPER NUMBER		
1628				
MAIL DATE		DELIVERY MODE		
10/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,967

Applicant(s)

GATTO, JOSEPH ANTHONY

Examiner

ANNA PAGONAKIS

Art Unit

1628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Action mailed on 4/2/2009 is hereby vacated and replaced with the current Action.

Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Objection

Claims 11-18 and 20-27 are objected for improper periods within the subparts of the claim. Proper form of claims dictates that only one period should be contained within a claim (i.e. at the end of the claim), unless it is used to denote a decimal point.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-18 and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "from about," "at least about" and "less than about" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "from" (a lower limit) or "about" (broadening limitation, both higher and lower) controls the metes and bounds of the phrase "from about." Regarding "at least" (a lower limit) or "about" (broadening limitation, both higher and lower) it is unclear

what controls the metes and bounds of the phrase "at least about." Regarding "less than (a lower limit) or "about" (broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "less than about."

Claims 11-18 and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "from about," "at least about" and "less than about" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "from" (a lower limit) or "about" (broadening limitation, both higher and lower) controls the metes and bounds of the phrase "at least about." Regarding "less than (a lower limit) or "about" (broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "less than about."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11, 21 and 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention.

Present claims are directed to a method for preparing a lotion for reliable high speed processing onto a substrate wherein said step of spraying, extruding or slot coating said lotion at a temperature from about 60 to 90 degrees Celsius and 70 to 90 degrees Celsius, respectively.

The specification and claims as originally filed fail to provide adequate written description for the newly amended limitation “a temperature from about 60 to 90 degrees Celsius” and “70 to 90 degrees Celsius” in claims 26-27. Applicant has not provided Applicant any direction as to where the newly added claim limitations can be found in the instant disclosure. Upon review of the disclosure, no such limitations, were found. While it is recognized that adequate written description of a limitation is not required to be stated in *haec verba* in the specification or claims as originally filed, adequate written support for all claim limitations must arise from either an explicit or implicit suggestion by the disclosure to show that such a concept as now claimed was actually in possession of the Applicant at the time of the invention.

MPEP 2163 states, “The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement, does the description clearly allow persons of ordinary skill in the art to recognize that he or she invention what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test of sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter,” *Ralston Purina Co. v. Far-Mar-Co., Inc.* 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983))... Whenever

the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)."

Accordingly, the claims are considered to lack sufficient written description and are properly rejected under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16 and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al. (U.S. 6,793,930, of record) and Osborne et al. (U.S. 6,716,441, of record).

Gatto et al. teaches that a skin care composition (see abstract) having the characteristics wherein the particle size of the skin care agent is less than 100 microns (see column 11, lines 35-50) results from milling (see column 16, line 34) and the carrier of petrolatum (see column 16, lines 45-49) wherein the composition can further comprise vitamins (see column 24, line 57). Finally, the use of a diaper is taught in Figure 1. It is found that the components may be thoroughly mixed to form a substantially uniform composition at temperatures which range from about from 40 degrees Celsius to about 100 degrees Celsius (column 31).

Osbourne et al. teach an effective delivery of a therapeutic skin care active to the skin via a novel release composition which is preferably incorporated into a dispensing means. Many types of disposable absorbent articles, such as diapers, training pants, adult incontinence devices, sanitary napkins, panty

liners and the like are available to absorb and contain urine and other bodily exudates (column 1, lines 1-18). Further, the dispensing means can include pump sprays and trigger sprays (column 2). Petrolatum is typically used to provide a long-lasting coating (column 1, lines 66-67). An article, such as those described, with a composition comprising niacinamide, panthenol, chitosan and vitamin C. Skin actives include calamine, cysteine hydrochloride, racemic methionine, sodium bicarbonate, vitamin C (column 5, lines 33-38) and talc (column 15, lines 55). Suitable solvents include propylene glycol and glycerines (column 16, line 28).

One of ordinary skill in the art would find it prima facie obvious to prepare a lotion using a carrier system such as petrolatum, talc or vitamin C and mixing it with niacinamide and propylene glycol at a temperature of about 35 and 50 degrees Celsius, because it is known in the art that petrolatum, talc and vitamin C as well as niacinamide and propylene glycol are known to be used on sanitary napkins or diapers effectively. Further, it is known that the ingredients are mixed at a temperature of 40 degrees Celsius to about 100 degrees. Finally, a means of dispersing via spray is known.

“[W]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro., 425 U.S. 273, 282 (1976). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” Id. at 1742.

Note: MPEP 2144.04 [R-1] Changes in Sequence of Adding Ingredients: Ex parte Rubin , 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al. (U.S. 6,793,930) and Osborne et al. (U.S. 6,716,441) as applied to claims 11-16 and 20-25 above, and further in view of Sharma et al. (U.S. 5,104,913).

Sharma et al. teach that milling of a composition including propylene glycol and petrolatum can produce particles typically having average particle size of about 2 microns (column 6).

One of ordinary skill in the art would have been motivated to use a milling as a means of reducing the micron size of the particles because it is known in the art that milling can produce a particle size of about 2 microns.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al. (U.S. 6,793,930) and Osborne et al. (U.S. 6,716,441) as applied to claims 11-16 and 20-25 above in view of Kelly (U.S. 5,264,205).

Kelly teaches that milling of a composition is done at a temperature of below 50 degrees Celsius (column 3).

One of ordinary skill in the art would have been motivated to mill the composition at a temperature of about 50 degrees Celsius because it is known that composition are effectively milled at this temperature.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614

